

**REMARKS**

Claims 1-62 remain pending in the application.

**Claims 1-16, 20-25, 29-47, 51-56 and 60-62 over McDowell in view of Lorello**

In the Office Action, claims 1-16, 20-25, 29-47, 51-56 and 60-62 were rejected under 35 U.S.C. §103(a) as allegedly being obvious over U.S. Patent Application Publication No. 2001/0034224 to McDowell et al. ("McDowell") in view of U.S. Patent No. 6,208,870 to Lorello et al. ("Lorello"). The Applicants respectfully traverse the rejection.

Claims 1-16, 20-25 and 29-31 recite a wireless **chat participant** corresponding to a forwarded registration notification message that is added to a **chat room** based on the forwarded registration notification message.

The Examiner acknowledged that "McDowell et al. fails to clearly disclose wherein a wireless chat participant corresponding to said forwarded registration notification message being added to a chat room based on said forwarded registration notification message." (see Office Action, page 5).

The reason "McDowell et al. fails to clearly disclose ... a wireless chat participant" and "a chat room", as acknowledged by the Examiner, is that McDowell's teachings are for instant messaging. In contrast to McDowell's teachings, the present invention relates to **CHAT ROOMS**. Instant messaging is **NOT** a chat room as Instant Messaging is a one-on-one conversation. These are point-to-point Instant Messaging conversations not a group style venue as in a **chat room**.

It is well settled that each and every claim limitation must be considered. As specified in MPEP §2143.03, entitled "**All** Claim Limitations Must Be Taught or Suggested": "To establish prima facie obviousness of a claimed invention, **all** the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). '**All** words in a claim must be considered in judging the patentability of that claim against the prior art.' *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970)." MPEP §2143.03 at 2100-133 (Rev. 2, May 2004). The Examiner has **failed** to consider

Applicants' claimed features that are directed towards a **chat participant** for a **chat room**.

Moreover, for McDowell to be modified to arrive at the claimed features, McDowell's entire invention would have to be modified to instead be directed to CHAT ROOMS. The Examiner's rejection has failed to address this serious shortcoming in McDowell, much less provide motivation as to why it would have been obvious to completely modify McDowell's invention to **instead** be directed to CHAT ROOMS, as recited by claims 1-16, 20-25 and 29-31.

The Examiner's motivation for the alleged obvious modification of McDowell was "in order to provide a chat participant to be added to a wireless chat room environment." (see Office Action, page 5). However, as discussed above, McDowell fails to disclose a chat participant or a wireless chat room environment, much less a chat participant that can be added to a wireless chat room environment. Thus, the Examiner's motivation is nonsensical in the **context** of McDowell's invention.

The Examiner relied on Lorello to allegedly make up for the acknowledged deficiencies in McDowell to arrive at the claimed features. The Applicants respectfully disagree.

Lorello is not prior art with respect to section 103 as it was co-owned at the time of filing with the instant application. The Examiner is respectfully requested to review the Certificate of Correction attached to Lorello. Since the Examiner's rejection cannot stand on McDowell alone, as acknowledged by the Examiner, the Applicants respectfully request that the rejection of claims 1-16, 20-25 and 29-31 be withdrawn.

Accordingly, for at least all the above reasons, claims 1-16, 20-25, 29-47, 51-56 and 60-62 are patentable over the prior art of record. It is therefore respectfully requested that the rejection be withdrawn.

**Claims 17-19, 26-28, 48-50 and 57-59 over McDowell in view of Lorello and Sandegren**

Claims 17-19, 26-28, 48-50 and 57-59 were rejected under 35 U.S.C. §103(a) as allegedly being obvious over McDowell in view of Lorello, and further in view of U.S. Patent No. 6,512,930 to Sandegren ("Sandegren"). The Applicants respectfully traverse the rejection.

As discussed above, Lorello is not prior art with respect to section 103 as it was co-owned at the time of filing with the instant application. Since the Examiner's rejection cannot stand on McDowell and Sandegren alone, as acknowledged by the Examiner, the Applicants respectfully request that the rejection of claims 17-19, 26-28, 48-50 and 57-59 be withdrawn.

Accordingly, for at least all the above reasons, claims 17-19, 26-28, 48-50 and 57-59 are patentable over the prior art of record. It is therefore respectfully requested that the rejection be withdrawn.

**Conclusion**

All objections and rejections having been addressed, it is respectfully submitted that the subject application is in condition for allowance and a Notice to that effect is earnestly solicited.

Respectfully submitted,



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